

1
2
3
4
5
6
7
8 **UNITED STATES DISTRICT COURT**
9 **SOUTHERN DISTRICT OF CALIFORNIA**
10

11 IN RE EX PARTE APPLICATION OF
12 LG ELECTRONICS DEUTSCHLAND
13 GMBH and LG ELECTRONICS
14 JAPAN, INC.,

15 Applicants.
16

CASE NO. 12cv1197-LAB (MDD)
ORDER GRANTING *EX PARTE*
APPLICATION FOR ORDER
PURSUANT TO 28 U.S.C. § 1782
[Doc. No. 1]

17 On May 16, 2012, LG Electronics Deutschland., et al., (“Applicant” or “LG”)
18 filed an Ex Parte Application for an Order Pursuant to 28 U.S.C. § 1782 Granting
19 Leave to Obtain Discovery from Qualcomm, Inc., (“Qualcomm”) for use in Foreign
20 Proceedings. (Doc. No. 1). The application seeks permission to serve a subpoena
21 upon Qualcomm to obtain information for use in certain lawsuits pending in
22 Germany and Japan brought by Mitsubishi Electric Corporation against LG alleging
23 patent infringement. The proposed subpoena requires the production of the
24 following:

25 “1. All Documents that grant or granted, or purport or purported to
26 grant, to Qualcomm any rights, protections, or licenses in or to any
27 Mitsubishi IPR—including without limitation Mitsubishi Wireless IPR,
28 regardless of whether it is Essential Wireless IPR – that provide or
provided a covenant not to sue relating to any Mitsubishi IPR, or that
otherwise authorize or authorized Qualcomm to practice any Mitsubishi
IPR, including but not limited to all agreements, amendments,

1 appendices, attachments, schedules, and addendums.

2 I. LEGAL STANDARD

3 A district court may grant an application pursuant to 28 U.S.C. § 1782 where:

4 (1) the person from whom the discovery is sought resides or is found in the district of
5 the district court to which the application is made; (2) the discovery is for use in a
6 proceeding before a foreign tribunal; and, (3) the application is made by a foreign or
7 internal tribunal or any interested person. *See, e.g., Lazaridis v. International Centre*
8 *for Missing and Exploited Children*, 760 F.Supp.2d 109, 112 (D.D.C. 2011).

9 Even if these requirements are met, a district court retains the discretion to
10 deny the request. *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 264
11 (2004); *In re Premises Located at 840 140th Avenue., N.E., Bellevue, Wash.*, 634 F.3d
12 557, 563 (9th Cir. 2011). The Supreme Court, in *Intel*, identified several factors that
13 a court should consider in ruling on a request under § 1782:

14 “(1) whether the material sought is within the foreign tribunal's
15 jurisdictional reach and thus accessible absent Section 1782 aid;
16 (2) the nature of the foreign tribunal, the character of the proceedings
17 underway abroad, and the receptivity of the foreign government or the
18 court or agency abroad to U.S. federal-court jurisdictional assistance;
19 (3) whether the Section 1782 request conceals an attempt to circumvent
20 foreign proof-gathering restrictions or other policies of a foreign country
21 or the United States; and,
22 (4) whether the subpoena contains unduly intrusive or burdensome
23 requests.”

24 542 U.S. at 264-65.

25 II. DISCUSSION

26 A. Authority to Issue Subpoena

27 Having reviewed the application and the response of LG, the Court finds that
28 the statutory requirements have been satisfied. Qualcomm is located in the Southern
District of California, there is a pending proceeding in the German and Japanese
courts and LG is an “interested party” as it is a named defendant in the German and
Japanese action.

//

//

1 B. Discretionary Factors

2 1. Jurisdictional Reach of Foreign Tribunal

3 The Supreme Court, in *Intel*, stated that,

4 “when the person from whom discovery is sought is a participant in the
5 foreign proceeding ..., the need for § 1782(a) aid generally is not as
6 apparent as it ordinarily is when evidence is sought from a
7 nonparticipant in the matter arising abroad. A foreign tribunal has
8 jurisdiction over those appearing before it, and can itself order them to
9 produce evidence. In contrast, nonparticipants in the foreign proceeding
10 may be outside the foreign tribunal's jurisdictional reach; hence, their
11 evidence, available in the United States, may be unobtainable absent §
12 1782(a)
13 aid.”

14 542 U.S. at 264.

15 In the instant case, Qualcomm is not a party to the German or Japanese
16 lawsuits so, on first blush, it appears that this factor should favor LG. But, the
17 information to be sought from Qualcomm, as provided above, relates exclusively to
18 Qualcomm's licensing or authorized use of Mitsubishi intellectual property.
19 Mitsubishi is the plaintiff in the German action. Mitsubishi must also be in
20 possession of that information. LG has not explained why that information cannot be
21 obtained from Mitsubishi in either lawsuit. Although § 1782 does not have an
22 “exhaustion” requirement, the Court is permitted, in deciding how to exercise its
23 discretion, to consider whether the applicant has availed itself of discovery
24 procedures in the foreign forum. *See In re Degitechnic*, 2007 WL 1367697 at *4
25 (W.D.Wash. 2007).

26 Accordingly, the Court finds that this factor actually weighs against granting
27 this application.

28 2. Nature and Receptivity of Foreign Tribunal

LG has made a sufficient showing that the German and Japanese courts would
be receptive to the introduction of evidence obtained pursuant to § 1782.
Consequently, this Court views this factor as favoring the Applicant.

//

//

3. Attempt to Circumvent Foreign Proof-Gathering Restrictions and Policies

Applicant claims to be “unaware of any restrictions on proof-gathering that would prohibit obtaining the discovery it seeks through Section 1782.” (Doc. No. 1 at 6). The Court finds that the Applicant has demonstrated relevance. On the other hand, as discussed above, LG has not addressed the availability of this information from Mitsubishi utilizing the discovery procedures of the host courts. So, while there is no evidence that LG is seeking to circumvent restrictions that may exist in the host courts, this factor does not help to convince the Court to exercise its discretion in favor of the Applicant.

4. Undue Intrusion or Burden

Applicant claims to have drawn a narrow subpoena so that the impact upon Qualcomm would be minimal. This Court is aware, however, that the type of information sought in this case normally is the subject of protective orders. *See, e.g., In re Apple*, 12cv179-LAB (POR), docket number 9. Having not suggested any limitation upon the use of this information, the Court has some concerns regarding confidentiality.

C. Final Analysis

The Court finds that the *Intel* factors do not clearly dictate the manner in which the Court should exercise its discretion in this case. But, considering that our courts favor broad discovery generally, the Court will authorize the issuance of the requested subpoena. The Court will require that the subpoena be served upon Qualcomm and upon Mitsubishi and include a copy of this Order.


III. CONCLUSION

The application is **GRANTED**. Applicant is **ORDERED** to serve the subject subpoena and a copy of this ORDER upon Qualcomm and upon Mitsubishi. Nothing herein prevents Qualcomm or Mitsubishi, as a party in interest, from asserting any rights it may have to challenge the subpoena after it is served. Any such challenge

1 must be filed as a motion in this docket.

2 IT IS SO ORDERED.

3 DATED: May 21, 2012

4 
5 Hon. Mitchell D. Dembin
6 U.S. Magistrate Judge
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28